

Who is the Boss now?

by Scott M. Hervey

While Bruce Springsteen may be the Boss to millions of fans, apparently two of the three panelists in the domain name dispute case, *Bruce Springsteen v. Jeff Bugar and Bruce Springsteen Club*, D2000-1532 (WIPO Jan. 25, 2001) thought otherwise. Some commentators have praised the decision in *Bruce Springsteen* as a proper analysis of the ICANN Uniform Domain Name Dispute Resolution Policy, or UDRP, while others have claimed the decision to be a tortured reading of the UDRP. Although the *Bruce Springsteen* decision has been criticized by other UDRP arbitration panels, the holding always finds its way into UDRP defendants' briefs.

Bruce Springsteen involved a fight over the domain bruce.springsteen.com. The respondent, Bugar, had registered the domain name in 1996. Springsteen and his record company registered the domain name bruce.springsteen.net in 1998. Since its registration, bruce.springsteen.net acted as the official Bruce Springsteen web site

As to the first element of proof a complainant in a UDRP proceeding must prove (that the domain name at issue is identical or confusingly similar to a trademark in which the complainant has rights), the majority of the panel in *Springsteen* questioned whether the Boss had met his burden. Springsteen owned no trademark registration covering "Bruce Springsteen" and the majority of the panel doubted that Springsteen had established common law rights. Given the lack of proof of trademark rights in the mark "Bruce Springsteen" the majority mused that "it is by no means clear from the UDRP that it was intended to protect proper names of this nature." However, the majority stated that because it was able to decide the case on other grounds, it would proceed on the assumption that Springsteen had established trademark rights in "Bruce Springsteen."

The dissenting panelist disagreed that Springsteen had not established trademark rights in "Bruce Springsteen." He noted that Springsteen is an internationally renowned composer, recording artist, singer and performer, and stated that the mark "Bruce Springsteen" has acquired secondary meaning and is the source of enormous goodwill for Springsteen.

Decisions in other domain name dispute cases have also found fault with the majority decision in *Springsteen*. In particular, these decisions take issue with the doubt *Springsteen* has cast on whether the UDRP was intended to provide protection for proper names. In *Celine Dion and Sony Music Entertainment (Canada) Inc. v. Jeff Bugar*, D2000-1838 (WIPO Feb. 13, 2001), *Julie Brown v. Julie Brown Club*, D2000-1628 (WIPO Feb. 13, 2001) and *Judy Larson v. Judy Larson Fan Club*, FA0101000096488 (Nat. Arb. Forum March 13, 2001) the panelists noted that it has been well established through a series of UDRP decisions that authors and performers may have trademark rights in their names by which they have become well known.

The majority of the panel in *Springsteen* also decided that Springsteen failed to establish that Bugar did not have any legitimate interest or right in the domain name. Particularly, the majority of the panel determined that Springsteen had not established

that the domain was being used for commercial gain or that it was misleading in its diversion of consumers to Bugar's celebrity1000.com website.

The portion of the *Springsteen* decision that is the most problematic (and the portion that is most likely to appear in a UDRP defendant's brief) is the majority's discussion of whether Bugar's registration of the domain had prevented Springsteen from reflecting his mark "in a corresponding domain name." The majority of the panel stated that "nothing that has been done by [the respondent] has prevented Bruce Springsteen's official website at bruce.springsteen.net being registered and used in his direct interest." The majority of the panel stated that had the respondent wanted to block the activities of Bruce Springsteen he could have registered *bruce.springsteen.net* and *bruce.springsteen.org* as well. However, because the respondent registered the domain in only the ".com" gTLD, the majority of the panel determined that Bruce Springsteen had not been prevented from reflecting his name in a corresponding domain name. The majority of the panel closed its discussion of this issue by commenting that "previous panels have all too readily concluded that the mere registration of the mark, and indeed other marks of a similar nature, is evidence of an attempt to prevent the legitimate owner of registered or common law trade mark rights from obtaining a 'corresponding domain name'."

If the *Springsteen* panel's analysis of paragraph 4(b) of the UDRP is correct, a cyber-squatter would be entitled to register almost every single domain name reflecting someone else's trademark. As long as the cyber-squatter left one domain name free in any of the gTLDs, he would not have prevented the mark owner from reflecting its mark in a corresponding domain.

This portion of the holding in the *Springsteen* case has been criticized in the *Celine Dion* and *Julie Brown* cases. There, the arbitrators questioned the *Springsteen* panel's interpretation of the phrase "reflecting the mark in a corresponding domain name" and whether that phrase referred to any domain name or a particular domain name, as *Springsteen* implies. If the phrase 'a corresponding domain name' is interpreted as referring only to one specific domain name, the arbitrators in those cases determined that bad faith would scarcely be established because the cyber-squatter would have to register the name in every single gTLD. UDRP could not have been drafted with such a narrow intent.

The *Springsteen* holding was also criticized in the *Judy Larson* case. There the arbitration panel stated that the suggestion of the majority opinion in *Springsteen* that a finding of bad faith is predicated on a respondent registering multitudes of domain names using variations on the mark so that the mark owner would be completely barred from registering its mark in one corresponding domain name, "results from a tortured reading of the [UDRP]." The arbitration panel rejected the *Springsteen* holding and found that the respondent's registration of the domain *judy.larson.com* prevented the complainant from reflecting her name in the most logical corresponding domain through which Internet users would find her.

Attorneys who practice in this area of the law anticipate that we have not seen the last of *Springsteen*. The panel's suggestion that the interpretation of the term "corresponding

domain name" is an issue which should be looked at more closely may gain relevance as the domain name space expands.

In this column, we have previously discussed that seven new gTLD extensions will be available shortly. A number of the new domains are limited to certain categories of industry or specific quality of the registrant (i.e. .aero for companies and individuals in the aerospace industry; .pro for professionals, etc.). Others such as .biz (businesses) and .info (information) are less limited. The availability of these new gTLDs begs the following question: if Springsteen registered the domains brucespringsteen.com and brucespringsteen.net, would Bugar's registration of brucespringsteen.info have prevented Springsteen from reflecting his mark in a corresponding domain name?